

REMARKS

Claims 1 and 7 have been amended to delete oxygen and sulfur from the definition of Z. Based on this amendment claims 5 and 6 have been withdrawn.

According to the Official Action, claims 1-8 and 79 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1-20 and 31-56 of US Patent application 10/632,950 and claims 1, 2, 4-20, 31-38 and 41-51 of co-pending application 10/032,392.

These rejections are respectfully traversed.

Firstly, these rejections are premature because the claims in US Patent applications 10/032,392 and 10/632,950 have not been patented.

Secondly, according to MPEP 804 in determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent?

In this case the answer is no. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

The claims in this application are not obvious over the claims of US patent applications 10/032,392 and 10/632,950. In claim 1 of this application the definition of Z has been amended to = CH, -CH₂ or NR^b. US Patent application 10/632,950. It is not obvious from the claims of US Patent application 10/632,950 that Z can be defined as = CH or CH₂. Furthermore, the definitions of R^b are not the same in the two applications.

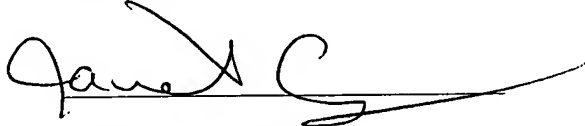
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In US Patent application 10/032,392, Z is defined as oxygen. Based on the claims as amended in this application 10/613,414, it is not obvious that Z can be defined as other than oxygen.

Therefore, since claims 1-8 and 79 in this US Patent application are not obvious over the claims of US Patent application 10/032,392 and 10/632,950 it is respectfully requested that these obviousness type double patenting rejections be withdrawn.

Applicants submit that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Janet I. Cord", with a long horizontal flourish extending to the right.

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